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10/087,384	03/01/2002	Cherita Arnece Peppers	16356.686 (DC-03130)	3346
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HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER ROMANO, JOHN J	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

10/087,384

Applicant(s)

PEPPERS ET AL.

Examiner

John J Romano

Art Unit

2122

-- The MAILING DATE of this communication appears on th cover sheet with the c rresp ndenc address --

**Peri d f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/1/02, 9/17/03, 6/27/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Pri rity under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/1/02</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

Claims **1-40** are pending in this action.

### *Information Disclosure Statement*

1. The Information Disclosure Statement filed on October 16<sup>th</sup>, 2002 has been considered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

3. Claims **1, 4, 5, 11, 12, 14, 17, 18, 24, 25, 28, 31, 32, 38** and **39** are rejected under 35 U.S.C. 102(e) as being clearly anticipated by van Gilluwe et al., US 6,351,850 B1 (hereinafter **van Gilluwe**).

4. In regard to claim **1**, **van Gilluwe** discloses:

- *"A method for an automated operating system upgrade in an information handling system, from an older version to a newer version, comprising: initiating a preparation for the upgrade from an operating system upgrade preparation media..."* (E.g., see Figure 5 & Column 4,

lines 3-11), wherein a storage medium on a computer system is prepared for the operating system upgrade.

- "... *determining an eligibility of the information handling system for upgrade in response to the preparation; and proceeding with the upgrade preparation in response to an eligibility determination, otherwise terminating the upgrade preparation.*" (E.g., see Figure 2 & Column 8, lines 33-44), wherein a determination is made in response to the preparation; and the preparation proceeds if the prior version exists, and if not the program terminates.

5. In regard to claim 4, the rejections of base claim 1 are incorporated.

Furthermore, **van Gilluwe** discloses:

- "... *executing a preparation program from the operating system upgrade preparation media, the program including instructions executable by the information handling system for scanning a current hardware configuration of the information handling system...*" (E.g., see Figure 5-7 & Column 6, lines 6-34), wherein the processor executes the instructions (line 6). The hardware configuration is obtained by reading the memory (scanning).
- "... *determining the eligibility of the information handling system for the upgrade includes comparing the scanned current hardware configuration with a listing of hardware configurations predetermined to be compatible with the newer version of the operating system.*" (E.g.,

see Figure 4 & Column 6, lines 42-49), wherein the configuration data is compared with the newer version configurations and the result or eligibility is determined.

6. In regard to claim 5, the rejections of base claim 4 are incorporated.

Furthermore, **van Gilluwe** discloses:

- "...retrieving a system identification from the information handling system, and further wherein determining the eligibility of the information handling system for the upgrade includes comparing the retrieved system identification with a listing of system identifications predetermined to be compatible with the newer version of the operating system." (E.g., see Figure 5 & Column 6, lines 35-49), wherein the operating system identification (line 38) is compared with the identification of the selected operating system and the result or eligibility is determined.

7. In regard to claim 11, the rejections of base claim 1 are incorporated.

Furthermore, **van Gilluwe** discloses:

- "...retrieving an identification of at least one software program from a system memory of the information handling system; determining an incompatibility of the software program with the upgrade operating system..." (E.g., see Figure 5 & Column 7, lines 5-11), wherein the retrieved installation characteristics of the identified operating system

to be installed are different than the identified program on the data storage medium.

- "...and providing a user-selectable option for automatically uninstalling the software program in response to an incompatible determination."

(E.g., see Figure 6 & Column 7, lines 5-23), wherein the user may delete or uninstall the software program in response to a difference from the critical characteristics or an incompatible determination.

8. In regard to claim **12**, the rejections of base claim **1** are incorporated.

Furthermore, **van Gilluwe** discloses:

- "...executing, in response to a completion of the automated operating system upgrade preparation, an upgrade operating system program from an upgrade operating system media." (E.g., see Figure 5 & Column 6, lines 50-62).

9. As per claims **14**, **17**, **18**, **24** and **25**, this is a computer program product version of the claimed method discussed above, in claims **1**, **4**, **5**, **11** and **12**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

10. As per claims **28**, **31**, **32**, **38** and **39**, this is a computer program version of the claimed method discussed above, in claims **1**, **4**, **5**, **11** and **12**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van**

**Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims **2, 3, 15, 16, 29** and **30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **van Gilluwe** in view of **Pedrizetti et al.**, US 6,151,708 (hereinafter **Pedrizetti**).

13. In regard to claim **2**, the rejections of base claim **1** are incorporated. But **van Gilluwe** does not expressly disclose a display page. However **Pedrizetti** discloses:

- "...prior to initiating the preparation, providing a user interface display page, the user interface display page outlining step-by-step upgrade instructions, the instructions including a user-selectable option to continue with the upgrade preparation." (E.g., see Figure 6A-6G & Column 8, lines 48-60), wherein a user interface display is shown (Figure 6A) and instructions are given when user interaction is needed

(step-by-step). Additionally, the upgrade preparation will continue with a user-selectable option as shown (Figure 6A).

**Van Gilluwe** and **Pedrizetti** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method for preparing to upgrade software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine **Pedrizettis'** user interface outlining instructions including a user-selectable option to continue with upgrade preparation with **van Gilluwe** upgrade preparation process. The motivation was disclosed by **van Gilluwe**, as he implicitly teaches instruction steps and user-options, e.g. see, "visual warning" on the "computer system display" (Column 7, lines 10-11). Thus it would have been obvious to implement **Pedrizettis'** more advanced user-display into **van Gilluwes'** preparation for the benefits of user-friendliness.

14. In regard to claim 3, the rejections of base claim 2 are incorporated.

Furthermore, **Pedrizetti** discloses:

- "...includes a web page." (E.g., see Figure 6A & Column 7, lines 42-45), wherein an html page is taught which contains the address of a web page.

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine **Pedrizettis'** web page with **van Gilluwes'** upgrade preparation process. The motivation was disclosed by **van Gilluwe**, as he teaches "a computer readable storage medium" for controlling a computer system to receive an operating system (Column 4, lines 32-44). Thus it would have been obvious



to implement **Pedrizetti's** web page to include all the benefits and motivation that an internet brings to modern systems.

15. As per claims **15** and **26**, this is a computer program product version of the claimed method discussed above, in claims **2** and **3**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

16. As per claims **29** and **30**, this is a computer program version of the claimed method discussed above, in claims **2** and **3**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

17. Claims **6-8**, **19-21**, **27** and **33-35** are rejected under 35 U.S.C. 103(a) as being unpatentable over **van Gilluwe** in view of **Dodson**, US 6,514,159 B1 (hereinafter **Dodson**).

18. In regard to claim **6**, the rejections of base claim **1** are incorporated. But **van Gilluwe** does not expressly disclose a retrieving a system BIOS and determining if it is current and if not upgrading or replacing it. However **Dodson** discloses:

- "...retrieving a system BIOS Rev from a system memory of the information handling system; and determining whether the system BIOS Rev is a current version and if not current, then obtaining an

*upgrade system BIOS Rev from the upgrade media and replacing the system BIOS Rev with the upgrade BIOS Rev.”* (E.g., see Figure 7 & Column 5, lines 44-55), wherein the MBU interface updates the BIOS upon the BIOS version or Rev being obtained and compared.

**Van Gilluwe** and **Dodson** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method for preparing to upgrade software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine **Dodsons’** BIOS revision with **van Gilluwes’** upgrade preparation process. The motivation was disclosed by **van Gilluwes’** concept itself as an operating system interfaces with the BIOS to interact with the hardware. Thus, it would have been obvious to one of ordinary skill in the art, to upgrade or replace a BIOS version when upgrading an operating system. Furthermore, an upgraded BIOS yields some of the same efficiency as the operating system, e.g. faster input/output, enhancing system performance, etc.

19. In regard to claim 7, the rejections of base claim 6 are incorporated. But **van Gilluwe** does not expressly disclose flashing the upgrade BIOS. However **Dodson** discloses:

- “...*flashing the upgrade BIOS Rev.*” (E.g., see Figure 10B & Column 6, lines 61-62), wherein the BIOS is flashed.

20. In regard to claim 8, the rejections of base claim 6 are incorporated. But **van Gilluwe** does not expressly disclose retrieving identification of a driver and in response copying an upgraded driver. However **Dodson** discloses:

- "...*retrieving an identification of at least one driver...*" (E.g., see Figure 2 & Column 2, lines 60-62), wherein determining the driver version or retrieving an identification of a driver is performed.
- "...*copying an upgrade driver from the upgrade media to the information handling system, the upgrade driver having been selected in response to the retrieved driver identification.*" (E.g., see Figure 3 & Column 3, lines 62 – Column 4, line 12), wherein the results are compared to a driver stack, a driver determined in response and then installed.

21. As per claims **19-21**, these are a computer program product version of the claimed method discussed above, in claims **6-8**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

22. As per claim **27**, the arguments and limitations from claims **14, 15, 17** and **19** are incorporated, wherein all claimed limitations have also been addressed and/or cited as set forth above.

23. As per claims **33-35**, these are a computer program version of the claimed method discussed above, in claims **6-8**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

24. Claims **9, 13, 22, 26, 36** and **40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **van Gilluwe** in view of **Dodson** and further in view of obviousness.

25. In regard to claim **9**, the rejections of base claim **8** are incorporated. But **van Gilluwe** and **Dodson** do not expressly disclose at least one of an audio driver, video driver, modem driver and network driver. However, at the time the invention was made, it would have been obvious, to one skilled in the art that the driver would include "...at least one of an audio driver, video driver, modem driver, and network driver." The motivation was disclosed by **Dodson** wherein he teaches to inspect the current drivers, compare and replace them based on the hardware configuration. It would be obvious to included a modem and network driver as **Dodson's** invention is performed on a distributed network and would thus require such drivers. Additionally, it is obvious to one of ordinary skill in the art to upgrade if necessary aforementioned drivers when upgrading an operating system. Thus, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include at least one of audio, video, modem or network driver in the driver upgrade.

26. In regard to claim **13**, the rejections of base claim **4** are incorporated.

Furthermore, **van Gilluwe** discloses:

- "... the current hardware information." (E.g., see Figure 5 & Column 6, lines 17-34), wherein the storage medium is hardware.

But **van Gilluw** does not expressly disclose "displaying the current hardware information" on a display device. However, it would have been obvious to display the

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information to a user to one of ordinary skill in the art. The concept of displaying the hardware information is motivated by **Dodson** (Figure 3, Column 3. lines 50-62), wherein the results are returned. Although it is not explicitly stated to display to the user, both **Dodson** and **van Gilluwe** imply the event in their main concept of an automated display. It is obvious that if an automated program needs input it interfaces with the user. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to shown the user what they have in order to assist the decision by the user. Thus, it would have been obvious, to one of ordinary skill in the art to combine a hardware information displayed to the user to the upgrade process.

27. As per claims **22** and **26**, these are a computer program product version of the claimed method discussed above, in claims **9** and **13**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

28. As per claims **36** and **40**, these are a computer program version of the claimed method discussed above, in claims **9** and **13**, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

29. Claims **10**, **23** and **30** are rejected under 35 U.S.C. 103(a) as being unpatentable over **van Gilluwe** in view of **Dodson** and further in view of **Pedrizetti**.

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30. In regard to claim 10, the rejections of base claims 1, 6 and 8 are incorporated.

But the combined teaching of **van Gilluwe** and **Dodson** do not expressly disclose automatically detecting the upgrade driver from a setting in a registry. However

**Pedrizetti** discloses:

- "...setting a registry in the information handling system, the registry configured to enable the newer version of the operating system to automatically detect the upgrade driver." (E.g., see Figure 2 & Column 4, lines 12-19), wherein the upgrade driver is selected for the driver ID automatically contained in the registry. Furthermore the "Windows Registry file" is disclosed which is known to one of ordinary skill in the art to automatically detect the upgrade driver.

**Pedrizetti** and the combined teaching of **Van Gilluwe** and **Dodson** are analogous art because they are both concerned with the same field of endeavor, namely, an automated method for preparing to upgrade software. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the combined teaching with **Pedrizettis'** teaching of a registry setting to automatically detect the upgrade driver. The motivation is taught by **van Gilluwe** (Column 8, lines 4-5), wherein, an automatic execution of the best method without user input is taught. Thus, it would have been obvious to one of ordinary skill in the art, to use a method that further automates the system. Further automation also increases efficiency, enhancing system performance.

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31. As per claim 23, this is a computer program product version of the claimed method discussed above, in claim 10, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

32. As per claim 37, this is a computer program version of the claimed method discussed above, in claim 10, wherein all claimed limitations have also been addressed and/or cited as set forth above, wherein **van Gilluwe** also discloses a computer readable storage medium storing "computer readable program code" (E.g. see, Figure 4 and associated text & Column 4, lines 32-40).

### ***Conclusion***

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Hiller et al., US006658659B2
- Stupek, Jr. et al., US005960189A

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J Romano whose telephone number is (571) 272-3872. The examiner can normally be reached on 8-5:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**

JJR